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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,660	09/28/2000	Kent D Henry	42074-00240	7946

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EXAMINER	
POLITZER, JAY L	
ART UNIT	PAPER NUMBER
2856	

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/672,660	Henry et al
Examiner	**Art Unit**
Jay Politzer	2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Dec 27, 2002 .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-85 is/are pending in the application.

4a) Of the above, claim(s) 1-59 and 74-85 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 60-73 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2, 3, 4
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Serial Number: 09/672,660
Art Unit: 2856

Title: TOOL ASSEMBLY AND MONITORING APPLICATIONS USING SAME
Filed: 9/28/00
Inventor(s): Henry et al
Attorney(s): Ken Johnson

DETAILED ACTION

ELECTION OF SPECIES:

1. In the amendment of 12/27/02 Applicant affirmed the election of Group II., claims 46-73. During a telephone conversation with Ken Johnson on 1/29/03 a provisional election was made without traverse to prosecute the species of claims 60-73 within the elected group. Affirmation of this election must be made by applicant in replying to this Office action. Claims 46-59 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

35 U.S.C. 101 READS AS FOLLOWS:

2. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

3. Claims 62 and 64-68 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

   Claims 62 and 64-68 are vague and indefinite in attempting to recite the method of operating the claimed apparatus and do not further limit the apparatus (i.e. the claim refers to more than one statutory class.) Ex parte Lyell, 17 USPQ 2d 1548 (Bd. Pat. App. & Inter. 1990)

4. Claims 62 and 64-68 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

REJECTIONS OVER PRIOR ART UNDER 35 U.S.C. § 103:

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

6. Claims 60-70 are rejected under 35 U.S.C. § 103 as being unpatentable over Granato et al, hereinafter Granato, in view of Dickel et al, hereinafter Dickel.

Regarding Claim 60; Granato teaches the claim in the abstract, sampling schedules at, and associated computer equipment at Col 6, Li 35-46. Granato fails to house the computer within the probe. Dickel teaches housing the computer within the probe in Fig 2. It would have been obvious to one of ordinary skill in the art at the time of the invention to house the computer within the probe to obtain real-time measurements when telemetry to the surface is impractical.

Regarding Claims 61 and 63; Granato fails to teach a switch. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a software and/or a hardware switch to change the sampling schedules which change with external

conditions at Col 5, Li 19-22, and Col 9, last ¶. It would have been obvious to one of ordinary skill in the art at the time of the invention to use pressure (level, Col 3, ¶ 2) change to trigger the schedule change.

Regarding Claim 62; Granato fails to teach different sampling frequencies. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide different sampling frequencies to sample at a higher frequency when conditions change rapidly.

Regarding Claim 64-68; Granato fails to teach file storage and manipulation strategies. It would have been obvious to one of ordinary skill in the art at the time of the invention to store and manipulate the data in many equivalent different art recognized ways to facilitate storing large amounts of data that are readily accessible.

Regarding Claims 69-70; Granato fails to teach a 4 volt unit with sleep/awake modes. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide this functionality because

modern laptop and portable computers use this technology to conserve battery power.

7. Claims 71-73 are rejected under 35 U.S.C. § 103 as being unpatentable over Granato/Dickel as applied to claim 60, above, and further in view of Rose and/or Gardner v. TEC Systems, Inc.

Regarding Claims 71-73; the claimed dimensions are not found in the prior art. However, the claimed relative dimensions would not perform differently than a larger prior art device. Further, unless there is some distinct technology employed to achieve the small claimed size, the smaller size is obvious over the prior art; and no such distinct technology is disclosed.

A. Changes in Size/Proportion

In re Rose , 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.).
In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

DESCRIPTION OF UNAPPLIED ART:

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure because it teaches other aspects of the claimed invention.

INQUIRIES:

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Jay L. Politzer whose telephone number is (703) 305-4930 and whose facsimile number is (703) 308-7382

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Hezron E. Williams, can be reached at (703) 305-4705.

11. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4900.

jlp 1/31/03

JLP

HELEN KWOK
PRIMARY EXAMINER